

**REMARKS** **BEST AVAILABLE COPY**

Applicants hereby reply to the Office Action mailed on September 30, 2005, within the shortened three-month period for reply. Claims 1-11 were pending in the application and the Examiner rejects claims 1-11. Applicants amend claim 1. Reconsideration is respectfully requested. No new matter is added by this Reply.

***Claim Rejections - 35 USC § 103***

The Examiner advised Applicants that under 37 C.F.R. § 1.56, Applicants are obligated to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made. Applicants respectfully assert that the subject matter of the various claims was commonly owned at the time the inventions covered therein were made and therefore, 37 C.F.R. § 1.56 does not apply.

The Examiner rejects claims 1-5 and 9-11 under 35 U.S.C. § 103(a) as being unpatentable over Black, U.S. Patent Application No. 2005/0122209 ("Black"). The Examiner claims that "Re claim 1, Black teaches a method for registering biometric information for use in a smartcard system, the method comprising: detecting a proffered biometric at a sensor to obtain a proffered biometric sample; verifying the proffered biometric sample; storing the proffered biometric sample; and associating the proffered biometric sample with a smartcard such that the smartcard system utilizes the proffered biometric sample to authorize a smartcard payment utilizing the smartcard." (Pages 2-3) Applicants respectfully traverse.

In general, Black discloses an identity authentication system comprising a device for capturing a customer signature. Black requires a user to provide an electronic signature using a stylus or other similar device ([0016], [0022]). Further, while Black discloses submitting personal data during the registration procedure (Fig. 5A), Black only discloses such personal data to be customer record numbers, customer bank account numbers, account balance, reference prints and reference signatures (Fig. 10A-B, 11A-B). Black is silent as to providing smartcard information, not because such information is obviously provided, but because Black does not enable both biometric registration and payment. Rather, Black merely provides access to a payment account "when the sensed digital signature matches a reference digital signature" ([0020]).

Further still, Black is limited to associating a single transaction account with the customer record (Figs. 10A-B, 11A-B, [0087]). That is, Black is limited to being associated with only one

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"customer account that is to be used for payment" ([0084]), and not a smartcard with multiple credit and/or debit accounts. Thus, Black does not teach or disclose at least "verifying said proffered biometric sample, wherein said proffered biometric sample is associated with at least two accounts, wherein each of said at least two accounts includes at least one of: a charge card account, a credit card account, a debit card account, a savings account, a private label account and a loyalty point account," as recited in independent claim 1.

Claims 2-5 and 9-11 indirectly and directly depend from claim 1 and contain all of the elements thereof. Therefore, Applicants respectfully submit that claims 2-5 and 9-11 are differentiated from the cited references at least for the same reasons as set forth above, in addition to their own respective features. Accordingly, Applicants respectfully request withdrawal of the rejection of claims 2-5 and 9-11.

The Examiner rejects claims 6-8 under 35 U.S.C. § 103(a) as being unpatentable over Black in view of Robinson, U.S. Patent Application No. 2003/0061172 ("Robinson"). Applicants traverse this rejection.

Robinson does not teach or disclose at least "verifying said proffered biometric sample, wherein said proffered biometric sample is associated with at least two accounts, wherein each of said at least two accounts includes at least one of: a charge card account, a credit card account, a debit card account, a savings account, a private label account and a loyalty point account," Moreover, claims 6-8 directly or indirectly depend from claim 1 and contain all of the elements thereof. Therefore, Applicants respectfully submit that claims 6-8 are differentiated from the cited references at least for the same reasons as set forth above, in addition to their own respective features. Accordingly, Applicants respectfully request withdrawal of the rejection of claims 6-8.

Applicants respectfully submit that the pending claims are in condition for allowance. The Commissioner is hereby authorized to charge any fees which may be required, or credit any overpayment, to Deposit Account No. 19-2814. Applicants invite the Examiner to telephone the undersigned if the Examiner has any questions regarding this Reply or the present application in general. A duplicate copy of this request is enclosed for your use.

Respectfully submitted,

Dated: November 30, 2005

By: 

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5

Serial No.: 10/710,334  
Docket No.: 70655.3100

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6

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